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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,222	03/12/2004	Dennis Scott Wolever	88265-7735	8552

28765 7590 10/04/2007

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EXAMINER	
STULII, VERA	

ART UNIT	PAPER NUMBER
1761	

MAIL DATE	DELIVERY MODE
10/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/800,222	WOLEVER ET AL.	
	Examiner	Art Unit	
	Vera Stulii	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 July 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14 and 34-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14 and 34-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The provisional rejection of claims 1, 14-19, 24, and 27-28 under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 14-18, 21, and 25-26 of copending Application No. 10/984,914, has been withdrawn due to the cancellation of conflicting claims.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2-13 remain provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 19-20 and 23-24 of copending Application No. 10/984,914.

Applicants' arguments filed July 12, 2007 have been fully considered but they are not persuasive. At page 6 of the response Applicants state that they plan to file a

terminal disclaimer in the future. However, this is not sufficient to remove the rejections, and thus they are maintained for the reasons of record.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-4 and 37 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 2-4, it is noted that filling is not a part of the shell.

Regarding claim 37, it is not clear how is it further limit claim 34, since both claims recite ice confection as a filling.

Applicants' arguments filed July 12, 2007 have been fully considered but they are not persuasive. Regarding claims 2-4, Applicants claim an edible fat-based shell for a confection (claim 1). Claim 2 recites the edible fat-based shell including a filling at least partially retained within the shell. It is noted that the filling is not a part of shell, but rather a part of a confection. Amendments of claims were not sufficient to remove the rejections, and thus they are maintained for the reasons of record.

Claim Rejections - 35 USC § 103

The rejection of claims 15-19, 21-24, and 27-28 under 35 U.S.C. 103(a) as being unpatentable over Carter et al (GB 1,017,480) in view of Kaiser et al (US 6391373), has been withdrawn due to the cancellation of claims 15-33.

The rejection of claims 20 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carter et al (GB 1,017,480) in view of Kaiser et al (US 6391373), and further in view of Pritchard et al (WO 0215706), has been withdrawn due to the cancellation of claims 15-33.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-14 and 34-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pritchard et al (WO 0215706) in view of Kaiser et al (US 6391373).

The references and rejections are incorporated as cited in the previous Office action mailed April 4, 2007.

It is noted that newly added claims 34-46, essentially differ from the previously rejected claims 1-14 in a preamble language of independent claims 1 and 34. The newly added independent claim 34 now recites "An ice confection comprising a packaging support ...". The preamble is followed by limitations as recited in claims 1, 4 and 6. The new language of the preamble does not add any patentable distinction to newly added

claims. It is also noted that Pritchard discloses an ice confection comprising a packaging support having a desired shape, an edible fat-based shell comprising one or more walls that are formed directly on the packaging support from an amount of an edible shell-forming composition and a filling of an ice confection in the shell (Abstract). Therefore newly added claims 34-46 are rejected for the reasons of record as stated in the previous Office action.

Applicant's arguments filed July 12, 2007 have been fully considered but they are not persuasive.

In response to Applicants' arguments that Pritchard does not plastic viscosity and a yield value of the edible shell forming composition, and that Kaiser et al do not teach cones, showering or ice confection (pages 6-7 of the Reply), Applicants are reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references (page 7 of the Reply), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case,

Pritchard discloses an ice confection comprising a packaging support having a desired shape, an edible fat-based shell comprising one or more walls that are formed directly (coated) on the packaging support from an amount of an edible shell-forming composition and a filling of an ice confection in the shell (Abstract). Pritchard also discloses that shell-forming composition comprises a confectionery fat (p. 4 line 23). Pritchard also discloses that shell-forming composition may be dark, milk or white chocolate (p. 4 line 28). Pritchard points out that "molten chocolate may be partly replaced by any suitable liquid or viscous edible product which undergoes a change to substantially solid state under the influence of temperature or due to a chemical reaction (p. 7 lines 32-35). Kaiser et al disclose fat-based chocolate composition having good rheological characteristics, i.e. is suitable for processing in enrobing (coating), extruding or molding operations having a plastic viscosity less than about 80 poise and yield value less than about 200 dynes/cm^2 comprising fat, emulsifier and sweetener. Kaiser et al also disclose that "proper viscosity and yield value of the chocolate are required for smooth and even flow of the chocolate over the surface of the food to be coated." (Col. 2 lines 9-11). Since Pritchard discloses coating using any chocolate containing material, and Kaiser discloses chocolate having good rheological characteristics for enrobing (coating), one of ordinary skill in the art would have been motivated to modify disclosure of Pritchard and to use chocolate as taught by Kaiser et al, since chocolate disclosed by Kaiser et al demonstrates good performance when used in enrobing (coating) and has a number of advantages such as smooth and even flow comparing to other chocolate composition.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vera Stulii whose telephone number is (571) 272-3221. The examiner can normally be reached on 7:00 am-3:30 pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VS

KEITH HENDRICKS
PRIMARY EXAMINER